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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09 575,189

05/23/2000

Kia Silverbrook

NPX001US

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01/15/2003

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

LEE, SEUNG H

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,189

Applicant(s)

SILVERBROOK ET AL.

Examiner

Seung H Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 23, 26, 34 and 38-74 is/are rejected.
- 7) ☒ Claim(s) 13-22, 25 and 27-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

☐ Information Disclosure Statement(s) filed: 1449 paper fee: 1449

## **DETAILED ACTION**

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

2. Claims 13-22 and 27-37 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

3. Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 25 is depend on claim 25 itself. Accordingly, the claims have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 38-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 38, line 4: "**substantially**" is indefinite and vague in its relationship to the coded data (i.e. what does it mean by reciting "substantially invisible coded data"?).

Re claim 58, line 2: The phrase "the possible values" lacks proper antecedent basis,

Re claim 59, line 1: The phrase "the possible values" lacks proper antecedent basis,

Re claim 69, line 1: The phrase "the printer" lacks proper antecedent basis.

Appropriate clarification and correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

... resulting in a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-7, 9-12, 23-24, 26, 38-44, 46-51, 53, 55-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Dymetman et al. (US 6,330,976)(hereinafter referred to as 'Dymetman').

Dymetman teaches an interface surface or marking medium including visible information and invisible coded data (col. 7, lines 43-62), a sensing device or a detection device (i.e., pointer (502), image capture device or camera (506)) wherein a processing device serves as a computer system receiving the indicating data (i.e., image data) from the camera and performing or decoding the image captured by the camera for executing the appropriate function that is coded within the image (Fig. 9; col. 7, lines 63-65; col. 16, lines 11-50) wherein the image is coincident with coded data taking the form of 47 bits of a page-identifier (302) and 16 bits of page location data (304) in which the page-identifier and page location data are discrete each other and has predetermined spatial extent on the surface, (Figs. 5A and 5B; col. 13, lines 1-32), the location identifier is encoded with barcode (col. 14, lines 25-38), location code uniquely defining the position (Fig. 3; col. 12, lines 30-56), the digital page having additional functionalities (i.e., common feature) on coded substrate to control peripherals (col. 23, line 10- col. 28, line 17), the coded zones (202) including a location of center (704) in which identified the orientation (Fig. 10; col. 16, lines 51-65), the markings are reflect the UV light when the marking are printed with UV ink and/or visible

colors (i.e., yellow, magenta, and cyan) (col. 11, lines 46- col. 12, line 29), the image is electrically readable form using the detection device remotely stored information (Fig. 15; col. 29, line 61- col. 62, line 19), a first set of markings or identity data (208) and a second set of markings or identity data (210) are featured on all the cell in format taking a form of a dot having a two possible value (Fig. 3 and 5A; col. 12, lines 30-56).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman in view of Shachar (US 6,012,102).

The teachings of Dymetman have been discussed above.

Although, Dymetman teaches the interface surface encoding with the barcode, he fails to teach or fairly suggest that the encoded barcode is two-dimensional barcodes.

However, Shachar teaches a bar code (12) can be encoded with the two dimensional barcode (see Fig. 1; col. 5, lines 5-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Shachar to the teachings of

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dimensional barcode since it is well-known fact in the art that the two-dimensional barcode can stored/encoded more information/data compared to the one-dimensional barcode, and therefore an obvious expedient.

10. Claims 52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman in view of Wike, Jr. et al. (US 5,719,385)(hereinafter referred to as 'Wike, Jr.')

The teachings of Dymetman have been discussed above.

Although, Dymetman teaches the interface surface encoding with the barcode, he fails to teach or fairly suggest that the encoded barcode is in a format incorporating redundancy of information.

However, Wike, Jr. teaches a bar code is characterized that by data redundancy (see col. 1, lines 14-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Wike, Jr. to the teachings of Dymetman in order to provide an improve the readability of the barcode means wherein the barcode supply same information when the barcode reader is scan/read the barcode from either direction, and therefore an obvious expedient.

***Additional Remarks***

11. The lack of an art rejection with this Office action is not an indication of allowable subject matter (i.e., even though the claims 13-22, 25, and 27-37 are rewritten or amended to overcome the Claim Objections as discussed above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Wellner [US 5,640,193], Longacre, Jr. [US 5,231,293], Poland [US 4,825,058], Reber et al. [US 5,940,595], Hudetz et al [US 5,978,773], Parry [US 6,148,331], Russell et al. [US 6,386,453] disclose an accessing the information of electronic media using sensing devices.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.lee@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Seung H. Lee  
Art Unit 2876  
January 09, 2003

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